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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,837	05/23/2007	Rory McCrae Tulloch	066455-0271	3744

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EXAMINER

BOMAR, THOMAS S

ART UNIT	PAPER NUMBER
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3676

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04/12/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,837	Applicant(s) TULLOCH ET AL.	
	Examiner Shane Bomar	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26, 29, 34 and 36-38 is/are rejected.
- 7) ☒ Claim(s) 27, 28, 30-33, 35 and 39-49 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 27 is objected to because of the following informalities: it is suggested that the recitation of “the resisting means resists movement” be changed to --the resisting means further [or additionally] resists movement-- since claim 26 already has the resisting means resisting a form of movement. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 26, 29, 34, and 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,082,457 of Best et al.

Regarding claim 26, Best et al disclose a downhole swivel joint assembly comprising first (1a) and second (15) components movable relative to one another in an axial direction along a longitudinal axis of the assembly, said components being movable relative to one another in said axial direction between a mechanically stable unactivated configuration (when there is no ball, it is not activated; not shown), in which relative rotational movement between the first and second components is prevented due to teeth 19, and a mechanically stable activated configuration (when the ball is in place, it is activated), in which said rotational movement is permitted due to the bearings 11; wherein the assembly further comprises means for resisting movement of said components from the unactivated configuration to the activated configuration, said means comprising a resiliently deformable member (22) arranged so as to be resiliently deformed when

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said components are moved from the mechanically stable unactivated configuration to the mechanically stable activated configuration shown in Figure 1 (col. 3, line 35 - col. 4, line 15).

Regarding claim 29, the force needed to move the components from the unactivated configuration to the activated configuration must inherently be greater than the force necessary to move the components from the activated configuration to the unactivated configuration because the spring force must be overcome to move the components from the unactivated configuration to the activated configuration.

Regarding claim 34, the first component (1a) is provided with means for connecting the assembly to further downhole equipment (3) located, in use, above the assembly; and wherein the second component (15) is provided with means (in the form of splines) for connecting the assembly to yet further downhole equipment (1 and 7) located, in use, below the assembly (Fig. 1).

Regarding claims 36 and 37, bearings 11, which inherently comprise rolling elements and races, are provided between the first and second components so as to assist in relative rotation between said components when said components are in the activated configuration (Fig. 1).

Regarding claim 38, the bearing 11 is located so as to be spaced from said second component (15) when said components are in the activated position (Fig. 1).

Allowable Subject Matter

4. Claims 27, 28, 30-33, 35, and 39-49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments with respect to claim 26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is (571)272-7026. The examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shane Bomar/
Primary Examiner, Art Unit 3676